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10/770,459	02/04/2004	Hiroshi Takemoto	248348US-3 DIV	1340
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GOFF II, JOHN L	
			ART UNIT	PAPER NUMBER
			1733	
			NOTIFICATION DATE	DELIVERY MODE
			09/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/770,459

Applicant(s)

TAKEMOTO ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/237,661.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 6/27/07.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/237,661, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The subject matter of the current and only claim, claim 1, was first introduced at the time of filing Application No. 09/777,847 as new claim 34. Claim 1 requires "curing said first adhesive and said second adhesive using UV light, wherein during the curing step said intermediate member can move due to contraction of at least one of

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said first adhesive and said second adhesive due to curing”. This limitation was not disclosed in Application No. 09/237,661 (there being no discussion in the application that the intermediate member can move due to contraction of the first and second adhesive rather there is only discussion that the intermediate moves due to contraction of the first and second adhesive during curing), and thus, as the current claim is directed to subject matter other than that disclosed in Application No. 09/237,661 the current claim is not entitled a priority benefit to Application No. 09/237,661. Claim 1 has the benefit of priority only to Application No. 09/777,847 which was filed 02/07/2001.

Oath/Declaration

4. The declaration submitted 2/4/04 is a copy of that submitted in Application No. 09/237,661, and as this application presents a claim for subject matter not adequately supported or enabled by Application No. 09/237,661 a supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification does not describe “curing said first adhesive and said second adhesive using UV light, wherein during the curing step said intermediate member can move due to contraction of at least one of said first adhesive and said second adhesive due to curing”. It is noted the limitation is supported by the originally filed claim, but it is noted supported by the specification which states at page 51, lines 9-13 “By contrast, errors ascribed to the contraction of the adhesive due to curing cannot be corrected by the position adjustment beforehand because the positional deviation of the individual member is proportional to the amount and area of application of the adhesive”. Thus, the specification is considered to describe curing the first adhesive and the second adhesive using UV light wherein during the curing step the intermediate member moves due to contraction of the first and second adhesives. There is no description that the intermediate member “can” move only that it does move due to contraction.

Claim Rejections - 35 USC § 103

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. '784 (U.S. Patent 6,000,784) in view of Ito (JP 58049636 and see also the abstract).

Takemoto et al. '784 is available as prior art under 35 U.S.C. 102(b) as the U.S. filing date of claim 1 is 02/07/2001 (the filing date of priority Application No. 09/777,847) as set forth above, and Takemoto et al. '784 published 12/14/99. In the event the U.S. filing date of claim 1 is shown to be entitled the filing date of priority Application No. 09/237,661 having a U.S. filing date of 1/27/99 then Takemoto et al. '784 is available under 35 U.S.C. 102(e). Takemoto et al. disclose a method of mounting an ink jet printhead comprising providing a first member (14 of Figure 13) and a chuck (24 of Figure 13) for positioning and fixing the first member, providing a second member (11a-d of Figure 13) and a chuck (27 of Figure 13) for positioning and fixing the second member, providing an intermediate member (13a-13d of Figure 13) between the first and second members, applying a first adhesive (15 of Figure 13) at the interface between the first member and the intermediate member, applying a second adhesive (15 of Figure 13) at the interface between the second member and the intermediate member, and curing the first adhesive and the second adhesive using UV light such that the intermediate member can move due to shrinkage considered contraction of the first and second adhesives during curing such that after curing the first member is accurately bonded to the second member through the intermediate member (Figures 11-13 and Column 8, lines 46-67 and Column 9, lines 1-67 and Column 10, lines 1-37). Takemoto et al. '784 also teach another embodiment comprising providing a first member (14 of Figure 25) and a chuck (24 of Figure 25) for positioning and fixing the first

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member, providing a second member (11d of Figure 25) and a chuck (27 of Figure 25) for positioning and fixing the second member, providing an intermediate member (13a of Figure 25) between the first and second members, applying a first adhesive (15 of Figure 25) at the interface between the first member and the intermediate member, applying a second adhesive (15 of Figure 25) at the interface between the second member and the intermediate member, and curing the first adhesive and the second adhesive using UV light such that the intermediate member can move due to contraction of the first and second adhesives during curing such that after curing the first member is accurately bonded to the second member through the intermediate member (Figure 25 and Column 15, lines 36-62 and Column 16, lines 25-45). Takemoto et al. are silent as to the curing using UV light including filtering the light such that the color of the intermediate member is maintained, it being noted the application of UV light in Takemoto et al. to cure the adhesives is through the intermediate member which is transparent (Column 10, lines 20-26). Ito discloses applying UV light to materials including adhesives, coatings, inks, etc. wherein the UV light below 360 nm is filtered and removed before the UV light contacts the materials to prevent the materials from discoloring (See the abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Takemoto et al. a step of filtering the UV light applied through the transparent intermediate member to remove wavelengths below 360 nm as shown by Takemoto et al. to prevent the intermediate member from discoloring and blocking the UV light.

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8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. '015 (U.S. Patent 6,627,015) in view of Ito.

Takemoto et al. '015 is available as prior art under 35 U.S.C. 102(e) as the U.S. filing date of claim 1 is 02/07/2001 (the filing date of priority Application No. 09/777,847) as set forth above, and Takemoto et al. '015 has a U.S. filing date of 3/10/1998. Takemoto et al. '015 discloses the same as Takemoto et al. '784 discussed in full detail above (See Figures 13 and 25 and Column 8, lines 50-67 and Column 9, lines 1-67 and Column 10, lines 1-40 and Column 15, lines 38-64 and Column 16, lines 28-48 of Takemoto et al. '015). Takemoto et al. '015 is combined with Ito in the same manner as Takemoto et al. '784 in view of Ito set forth above.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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10. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,627,015 in view of Ito. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of U.S. Patent No. 6,627,015 fully encompasses and discloses all the limitations of claim 1 of the instant Application except for the curing using UV light including filtering the light such that the color of the intermediate member is maintained which is obvious in view of Ito as set forth above, it being noted UV ray curable adhesive applied to adhering surfaces of the intermediate member as set forth in claim 6 is considered applying adhesive to at least two surfaces of the intermediate member, i.e. a first adhesive to a first surface and a second adhesive to a second surface of the intermediate member.

Response to Arguments

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

The new claim limitation is addressed above.

Applicants argue, "In particular, Applicants note that the specification states that "in the above condition, the positional relations between the part 2 and the intermediate member 4 and between the part support 3 and the intermediate 4 are quite likely to differ from the time of position adjustment to the time of completion of the assembly ... errors ascribable to the contraction of the adhesive due to curing can be corrected by the position adjustment beforehand because the positional deviation of the individual member is proportional to the amount and area of application of the adhesive." "

The examiner has interpreted page 51, lines 2-13 of the specification as providing support for curing said first adhesive and said second adhesive using UV light wherein during the curing step said intermediate member moves due to contraction of said first adhesive and said second adhesive. The specification specifically describes that the adhesive contracts wherein it is then inferred by applicants and the examiner that the contracting adhesive moves the intermediate member which is the described positional deviation. However, there is no description within the specification that the contracting adhesive can move the intermediate member, i.e. may or may not move the intermediate member, wherein the only support for such language is the originally filed claim, and thus, priority is only granted to the extent described above.

Applicants further argue, “Moreover, Applicants note that page 4, lines 9-13 of the specification state that “if light for curing the adhesive applied to the interface is not uniformly distributed, a part of the adhesive is rapidly cured while the other part is slowly cured. As a result, the thickness of the adhesive layer differs from the part cured rapidly to the part cured slowly.” Thus, the specification discloses that the thickness of the adhesive layer will not only change with the curing process, it will depend on whether the adhesive is cured rapidly or cured slowly.”.

The claims are not commensurate in scope with any argument regarding the thickness of the adhesive as it relates to the speed with which parts of the first and second adhesive are cured.

Applicants further argue, “The ‘636 patent is directed to a glass filter for hardening of coating material, adhesive agents, etc. by UV radiation. In particular, the ‘636 patent discloses that coloration of an adhesive agent, ink, coating material, etc. by UV radiation having wavelengths of 250-350 nm is prevented and that radiation having a wavelength of 360 nm is

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effective for hardening these materials. However, Applicants respectfully submit that the '636 patent fails to disclose that the curing step includes filtering the light such that a color of the intermediate member is maintained, as recited in amended Claim 1.”.

It recognizes that applying UV light to materials including adhesives, coatings, inks, etc. discolors the materials such that the UV light below 360 nm is filtered and removed before the UV light contacts the materials to prevent the materials from discoloring wherein the same would have been obvious to include in Takemoto et al. to prevent the transparent intermediate member from discoloring and blocking the UV light.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

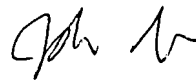
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John L. Goff
Primary Examiner
Art Unit 1733